

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION FOR ENTRY OF AFTER FINAL AMENDMENT FOR WHICH ENTRY
WAS REFUSED

APPLICANTS: Birkhoelzer et al. GROUP ART UNIT: 2152
SERIAL NO.: 09/992,974 EXAMINER: Ramsey Refai
FILED: November 19, 2001 CONFIRMATION NO.: 7671
TITLE: "MEDICAL SYSTEM ARCHITECTURE WITH A
WORKSTATION AND A CALL SYSTEM"

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

S I R:

In response to the Final Rejection dated September 15, 2005, Applicants filed Amendment "C" under 37 C.F.R. §1.116 on January 17, 2006. In an Advisory Action dated February 1, 2006, it was stated that the Amendment will not be entered because it does not place the application in condition for allowance, because "newly amended claims contain features not previously presented and would therefore require further search and consideration by the Examiner." This Advisory Action was rendered in the name of the above-noted Examiner, but was signed by the Examiner's SPE.

The language added to the claims in Amendment "C" did nothing more than insert "medical" or "examination" at a few locations, so that the complete term "medical examination images" is used consistently throughout the claims. No other change in the claims was made in Amendment "C". These changes were made in response to a specific rejection under 35 U.S.C. §112, second paragraph on this point that was made in the aforementioned Final Rejection. Moreover, the term

"medical images" was already present in the previous language of claim 1 (penultimate line thereof).

In the rejection under §112, the Examiner stated claim 1 recites the limitations "said examination images" in line 5 and "said medical images" in line 11, and the Examiner stated there is insufficient antecedent basis for these limitations in the claim. The Examiner was clearly incorrect with regard to "said examination images" in line 5 of claim 1, since the term "examination images" was used in claim 1 in line 2. In response to the Examiner's rejection, the term "said medical images" in line 11 of claim 1 was editorially amended to refer to "said medical examination images," and in view of this change the previous references to "examination images" in claim 1 were editorially revised so that the term "said medical examination images" was used throughout. As the Examiner noted, the term "said medical images" was already present in claim 1. Applicants respectfully submit these purely editorial changes in claim 1 (and a consistent change in claim 13) fall squarely within 37 C.F.R. §1.116(b)(1), as being an amendment "complying with any requirement of form expressly set forth in a previous Office Action." This type of editorial amendment is an amendment that is expressly stated to be permissible after a Final Rejection.

Applicants recognize that simply because an amendment is in the category of being permissible under 37 C.F.R. §1.116 does not create a right to have such an amendment entered, but Applicants respectfully submit that when an amendment, such as Amendment "C", clearly falls within the type of amendment permitted under 37 C.F.R. §1.116, the Examiner must provide a persuasive reason for not entering such an amendment. Applicants respectfully submit neither the Examiner nor his SPE have done so in the Advisory Action. Obviously the Examiner had to consider

this very issue in making the aforementioned rejection under §112, second paragraph, and therefore Applicants' response thereto cannot, by itself, raise a "new issue." Moreover, in view of the purely editorial nature of these amendments, it is unfathomable that the Examiner could believe that these minor editorial changes would require "further search or consideration" by the Examiner.

In the absence of any more enlightening information from the Examiner substantiating a reason for not entering Amendment "C", Applicants respectfully submit the Examiner has no statutory authority to refuse entry of Amendment "C".

Moreover, if the Examiner was merely adhering to a policy within the Examiner's examining group that an amendment filed after a Final Rejection that does not place the application in condition for allowance will automatically not be entered, Applicants respectfully submit this policy is at odds with the public policy that is currently being advertised by the Patent and Trademark Office as the reason why extensive rule changes are necessary to curtail the large number of continuation applications that are being filed. For the purpose of this discussion, the Commissioner considers Requests For Continued Examination to be a "continuation application." As stated in the Press Release dated February 1, 2006 (Attachment "A"), the filing of continuations "with only minor changes" wastes the limited time that Examiners have to review an application, and prevents Examiners from focusing on the most important issues in an application.

Additionally, in the PTO comments accompanying the rule changes on this point published in the Federal Register, Volume 71, No. 1 on January 3, 2006 (Attachment "B"), it is stated at page 49, in the center column just below the bold face heading "Supplementary Information", that the current volume of Continued Examination filings - including both continuing applications and requests for continued examination- and duplicate applications that contain "conflicting" or patentably indistinct claims, are having a *crippling effect* on the Office's ability to examine "new" (i.e., non-continuing) applications (emphasis added).

If it is the policy of the Examiner's examining group to automatically refuse entry of an amendment such as Amendment "C", thereby necessitating the filing of an RCE if the Applicants desire to have this amendment entered, this policy is clearly contributing to the aforementioned problem of wasting Examiners' time and having a crippling effect on the ability of the Office to examine new applications. Therefore, if Amendment "C" was refused entry because of such a policy in the Examiner's group, that policy is in need of revision since it is clearly out of step with the public pronouncements being made by the Commissioner.

Lastly, a Notice of Appeal is being filed simultaneously herewith, and entry of Amendment "C" will reduce the issues for appeal.

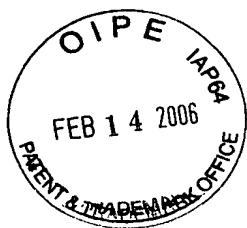
For all of the above reasons, entry of Amendment "C" was proper, and Amendment "C" should have not have been denied entry. Entry of Amendment "C" is therefore respectfully requested.

This Petition is accompanied by a check for the requisite fee in the amount of \$400.00.

Submitted by,

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(Reg. 28,982)



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on February 10, 2006.

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